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PATENT, TRADEMARK, COPYRIGHT
 AND UNFAIR COMPETITION LAW
 AND RELATED LITIGATION

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 EDWARD B. EVANS 1936-1971

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July 25, 2003

FACSIMILE COVER SHEET

To: Examiner Geoffrey R. Akers
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22213-1450

From: Scott A. Stinebruner
 Reg. No. 38,323

Fax: 703-872-9326

Re: U.S. Patent Application
 Serial No. 09/775,002
 Filed: February 1, 2001
 Applicant: Ron Joseph
 Art Unit: 3624
 Confirmation No.: 7478
 Our Ref: SWAP/03

Enclosures:

Fax Cover Sheet containing Certificate of
 Facsimile Transmission
 Transmittal (in duplicate) containing Certificate
 of Facsimile Transmission and a Request for
 a One Month Extension of Time and
 Permission to Charge Deposit Account
 23-3000 the sum of \$55.00 for Fee
 Change of Correspondence Address and
 Revocation and Election under 37 CFR §§
 3.71 and 3.73 and Power of Attorney
 Response

Pages: 13 (including cover sheet)

Official

FAX RECEIVED

JUL 28 2003

GROUP 3600

MESSAGE/COMMENTS

OFFICIAL

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and the enclosures noted herein (13 total pages) are being transmitted via facsimile transmission to Examiner Geoffrey R. Akers, for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 at 703-872-9326 on July 25, 2003.

Judith L. Volk
 Judith L. Volk

July 25, 2003
 DJC

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PATENT

Atty Docket: SWAP/03/124
Confirmation No. 7478

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and the enclosures noted herein (13 total pages) are being transmitted via facsimile transmission to Examiner Geoffrey R. Akers, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 at 703-872-9326 on July 25, 2003.

Judith L. Volk
Judith L. Volk

July 25, 2003
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ron Joseph Art Unit: 3624
Serial No.: 09/775,002 Examiner: Geoffrey R. Akers
Filed : February 1, 2001
For : SYSTEM AND METHOD FOR FACILITATING TRANSFER OF VEHICLE LEASES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT TRANSMITTAL

1. ☒ Transmitted herewith is a Change of Correspondence Address and Revocation and Election under 37 CFR §§ 3.71 and 3.73 and Power of Attorney, and a Response.
2. ☒ Small Entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ Enclosed is a verified statement to establish Small Entity status
- ☐ Other than a Small Entity
3. The fee has been calculated as shown below:

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GROUP 3600

CALCULATION OF FEES

Fee:	Number of Claims After Amendment:		Previously Paid For:	No. Extra:	At Rate:	Amount:
Total Claims	41	minus	41	0	\$9	\$0.00
Independent Claims	6	minus	6	0	\$42	\$0.00
MULTIPLE DEPENDENT CLAIM FEE					\$140	\$0.00
TOTAL FEE FOR CLAIMS:						\$0.00

- ☒ **No additional fee for claims is required.**

4. ☐ Attached is a check in the sum of \$_____ for additional claims.
- ☐ Please charge my Deposit Account No. 23-3000 in the amount of \$_____.
5. The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply. Complete (a) or (b) as applicable.

- (a) ☒ Applicant petitions for an extension of time under 37 CFR 1.136 for the total number of months checked below:

	<u>Ext. Mos.</u>	<u>Large entity</u>	<u>Small entity</u>
<input checked="" type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 410.00	\$ 205.00
<input type="checkbox"/>	three months	\$ 930.00	\$ 465.00
<input type="checkbox"/>	four months	\$1,450.00	\$ 725.00
<input type="checkbox"/>	five months	\$1,970.00	\$ 985.00

Extension fee due with this request:

\$ 55.00

Method of Payment:

Please Charge Deposit Account 23-3000 in the amount of \$55.00

If an additional extension of time is required, please consider this a petition therefor.
(Check and complete the next item, if applicable)

- ☐ An extension for ____ months has already been secured and the fee paid thereof of \$____ is deducted from the total fee due for the total months of extension now requested. Extension fee due with this request \$____.
- OR**
- (b) ☐ Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.
6. ☒ If any additional fee for claims or extension of time is required, charge Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By:

Scott A. Stinebruner
Reg. No. 38,323

2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202-2917
(513) 241-2324

Enclosed:

Fax Cover Sheet containing Certificate of Facsimile Transmission
Transmittal (in duplicate) containing Certificate of Facsimile Transmission and a Request for a One Month Extension of Time and Permission to Charge Deposit Account 23-3000 the sum of \$55.00 for Fee
Change of Correspondence Address and Revocation and Election under 37 CFR §§ 3.71 and 3.73 and Power of Attorney
Response

Official

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JUL 28 2003

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PATENT

SWAP/03
Confirmation No. 7478#10
8/14/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ron Joseph
Serial No.: 09/775,002
Filed: February 1, 2001
For: SYSTEM AND METHOD FOR FACILITATING TRANSFER OF VEHICLE
LEASES

Art Unit: 3624
Examiner: Geoffrey R. Akers
Atty. Docket No.: SWAP/03

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the Office Action dated March 26, 2003. A request for a one month extension of time is being submitted concurrently herewith, and thus the response date extends up to and includes July 26, 2003. Reconsideration and allowance of all pending claims are respectfully requested. Please also note that future communications should be made with the undersigned Attorney of Record by virtue of the Change of Correspondence Address and Power of Attorney form enclosed herewith.

In the subject Office Action, claims 1-41 were rejected both under 35 U.S.C. §112, ¶2 as being indefinite, and under 35 U.S.C. §103 as being obvious in view of "Lineback Enterprises Online Auto Leasing" (*hereinafter* Lineback) in view of U.S. Patent No. 6,237,009 to Waldo et al. (*hereinafter* Waldo).

Applicant respectfully traverses the Examiner's rejections to the extent they are maintained.

Turning first to the Examiner's rejection of claims 1-41 under 35 U.S.C. §112, ¶2, the Examiner rejects all claims based upon the reasoning that "[t]he independent claims are too broad to sufficiently indicate the distinctive characteristics of the disclosure." (Office Action, ¶6).

The rejection cannot be sustained, however, as the Examiner has failed to point out any particular claim language that the Examiner finds objectionable. The rejection appears to be

nothing more than an open invitation for Applicant to narrow the claims, something Applicant respectfully declines to do without sufficient justification. Moreover, without guidance from the Examiner, Applicant is unsure as to what particular language the Examiner finds to be indefinite, or how any such language could be corrected. It is Applicants understanding that a rejection under §112, ¶2 must point out specific objectionable claim language, and given that the instant rejection is deficient on this grounds, Applicant respectfully requests withdrawal of the rejection, or in the least, additional guidance from the Examiner in the next Official Communication.

In addition, even if the rejection was of such a manner that specific objectionable language needn't be cited in the rejection, it is further Applicant's understanding that a §112, ¶2 rejection based upon undue breadth is improper as a matter of law. "While . . . claim language . . . may be broad, breadth is not indefiniteness." Buell v. Beckstrom, 22 USPQ2d 1128, 1133 (Bd. Pat. App. Int. 1992). The instant rejection apparently is based upon the fact that the claims are too broad - a fact that is *irrelevant* to §112, ¶2.

Applicant therefore respectfully requests withdrawal of the 35 U.S.C. §112, ¶2 rejection of claims 1-41.

Now turning to the art-based rejections, Applicant initially traverses the rejection of claims 1-41 on the basis that the primary reference to Lineback is has not been shown to meet the requirements of a reference under 35 U.S.C. §102. In particular, the Examiner cites the publication date of Lineback as 1991, apparently due to the text in the reference referring to "Leasing Luxury Autos and SUVs in the United States since 1991." This text, however, is insufficient to establish an effective date for the reference.

For a reference to be properly citeable against a patent application, it must first be established that the publication date of that reference (e.g., the date of online availability in the case of an electronic document) is prior to the earliest effective filing date of the application. The date of 1991 discussed in the reference, however, suggests at the most prior activities, and not an actual publication date for the reference.

Indeed, the fact that this reference lists several 2003 model automobiles for lease, it is readily apparent that the publication date of this reference was both well after the asserted date of 1991, and well after the earliest effective filing date of the Application (February 4, 2000).

Applicant is confident that 2003 model automobiles were not available for lease in 2000, much less in 1991. The reliance on 1991 as a publication date for the reference is therefore in error, and any rejection that relies on Lineback should be withdrawn absent proof of a prior publication status for the reference.

Furthermore, even if the Examiner chooses to rely on Lineback only as evidence of activities occurring prior to Applicant's earliest effective priority date, Lineback still fails to meet the proper evidentiary burden. The Examiner relies on Lineback for allegedly disclosing "online leasing of automobiles." (Office Action, ¶4). The aforementioned text in the reference, however, only refers to "Leasing Luxury Autos . . . since 1991." Thus, there is no disclosure in the reference of leasing automobiles online since 1991, as purported by the Examiner. As a result, Lineback is also insufficient as evidence of relevant activities prior to Applicant's earliest effective filing date.

Accordingly, Applicant respectfully submits that the Lineback reference has not been shown to be properly citeable against the instant application. Therefore, Lineback should be removed as a reference, and the rejection of claims 1-41 should be withdrawn.

Applicant further notes, however, that even were Lineback properly citeable against the instant application, and did disclose the concept of online leasing, the combination of Lineback and Waldo would still be insufficient to render any of claims 1-41 unpatentable.

As disclosed in the application, Applicant's claims are directed to various inventions associated with bringing together people who lease automobiles but want to get out of their lease prior to the end of their lease term with people who may be interested in taking over their existing lease for the remainder of their lease term. In this regard, claim 1 recites a method for facilitating transfer of automobile leases, including *inter alia* the creation of records including details of leased automobiles and owners thereof, and the use of a website to permit a visitor to view such records.

Even assuming *arguendo* that Lineback discloses online leasing, Lineback would still fail to disclose or suggest the *transfer* of leases. Moreover, Lineback neither discloses nor suggests any functionality for storing records detailing *leased* automobiles and the owners thereof. Indeed, even if Lineback did disclose functionality such as a searchable database that prospective

lessee's could access to find automobiles to lease, the records in this hypothetical database would only include information about *unleased* automobiles.

In addition, Waldo adds nothing to the Examiner's rejection. Waldo discloses a resource management system that permits clients and other network services in a networked computer environment to "lease" system resources such as memory for periods of time, for the expressed purpose of preventing inadvertent garbage collection of a resource being held by a client due to network errors (col. 4, lines 51-67).

Thus, the usage of the term "lease" in Waldo has nothing to do with an automobile lease, which is the subject of claim 1. Instead, the term is used to refer to a requested time interval that an application can make in the Waldo system to ensure that the resource will not be collected during that time interval (col. 8, lines 25-35).

It is readily apparent from the application that the term "automobile lease" refers to a financial transaction in which an automobile is effectively rented for a fixed period of time for a monetary fee. Waldo has absolutely nothing to do with any financial transactions, nor does Waldo attempt to address any of the problems addressed by claim 1, and as such, Waldo is completely irrelevant to claim 1.

Applicant therefore respectfully submits that claim 1 is non-obvious over the combination of Lineback and Waldo. Reconsideration and allowance of the claim are therefore respectfully requested.

Next, with respect to independent claims 2, 29, 31, 35, and 40, each of these claims is directed in part to the concept of facilitating the transfer of vehicle leases using a database of vehicle lease records concerning vehicle leases available for transfer.

As an initial matter, Applicant notes that the rejection fails to address any of these claims specifically, or to apply the cited references against the specific language in each of these claims. In this regard, the rejections of these claims are deficient on their face.

Nonetheless, as noted above in connection with claim 1, Lineback, even assuming *arguendo* establishes the conventionality of online leasing, does not disclose or suggest transferring leases, or storing records in a database for vehicle leases available for transfer. Moreover, Waldo is completely irrelevant to the concept of a financial instrument such as a

vehicle lease. Accordingly, Applicant respectfully submits that claims 2, 29, 31, 35, and 40 are likewise non-obvious over the combination of Lineback and Waldo. Reconsideration and allowance of these claims are therefore respectfully requested.

As a final matter, in the interest of prosecutorial economy Applicant will not separately address any of dependent claims 3-28, 30, 33-34, 36-39 and 41, as these claims are patentable by virtue of their dependency upon one of the aforementioned independent claims. Applicant does wish to note for the record, however, that none of these claims have been specifically addressed in the rejections, and as such, the rejections of these claims are deficient on their face, and should be withdrawn. Moreover, many of these claims recite subject matter that is additionally distinguishable over the prior art of record, but which will not be addressed at this time.

If there are any questions regarding this paper, or which might otherwise further this case onto allowance, please contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

July 25, 2003
Date

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Scott A. Stinebruner
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